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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,959	04/02/2004	Sonke Horn	41653-201083	7731

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VENABLE LLP
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WASHINGTON, DC 20043-9998

EXAMINER

LAZORCIK, JASON L

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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12/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,959

Applicant(s)

HORN ET AL.

Examiner

Jason L. Lazorcik

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

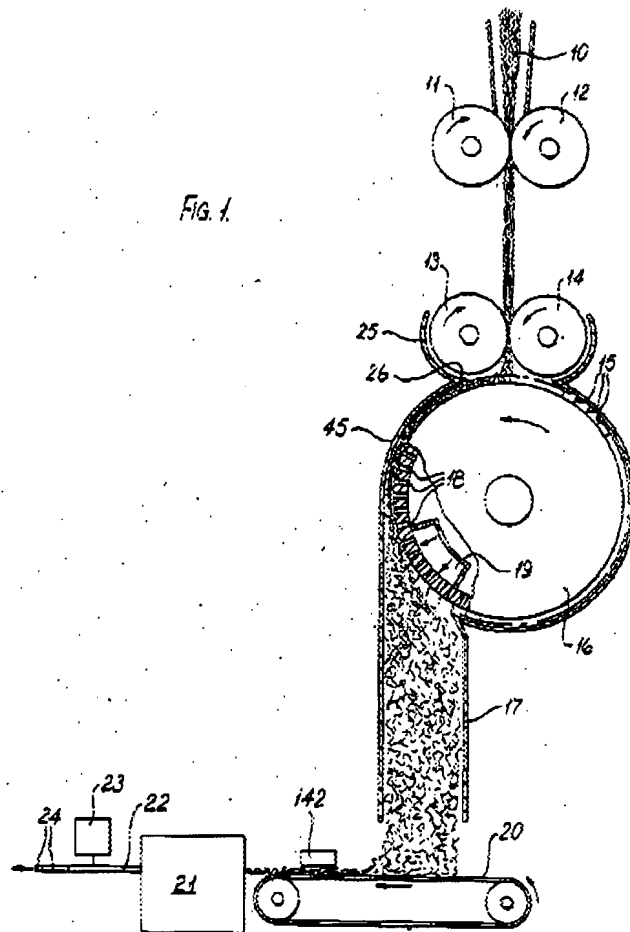
Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Preston (US 4,593,706).

With particular reference to the following excerpt Figure 1 below, Preston teaches an apparatus for processing a mass of filter material (10) comprised of fibers of finite length for manufacture into a filter element. The apparatus disclosed in the Preston reference comprises a metering device (11, 12), a separating device (16, 45), and a means for feeding the filter material from the metering device to the separating device (13, 14, 25).

The metering device comprises a drop chute (depicted flanking the tow (10)) and a pair of rotating rollers (11, 12) located in the lower region of said drop chute for removing the fibers therefrom (**Claim 21,22**). The reference teaches these rotating rollers (11,12) act as the claimed "fiber separating element" (**Claim 24**) by cooperating with the rollers 13 and 14 to "stretch the tow" (Column 3, lines 35-43).



With respect to the separating device, Preston teaches the claimed rotating element (16), the periphery of which is "formed with approximately radial passages (18) through which air is blown outward" (**Claims 18, 19, 23**).

Regarding the claimed mixing device, Preston teaches that "there may be means for applying a plasticizer, e.g. in any known manner; alternatively, plasticizer may be blown out through the passages (18) or otherwise applied after the tow has reached the roller (16) and at least partially broken". Where application of the plasticizer is viewed as a positive step of mixing the fibers and other additives together, the separating device (16, 45) is understood to serve a dual role as the claimed "mixing device"

(**Claims 25, 26**). Under an alternate embodiment, Preston teaches that the plasticizer "could be applied by the guiding means, i.e. before the filaments are broken". Under this latter embodiment, the mixing device is understood to comprise the guiding members of the fiber metering device (**Claim 27**).

Response to Arguments

Applicant first argues that the filter tow (10) of the Preston reference represents "a stream of continuous fibers" and thereby concludes that said reference does not disclose the step of processing a mass of filter material comprised of fibers of "finite length".

Applicant next argues that the rollers 11 and 12 are "designed to convey a continuous stream of fibers in the form of filter tow (10). From this allegation, Applicant concludes that said rollers (11, 12) are necessarily inoperative to effect controlled metering of fibers of finite length.

It is the Examiners understanding that both of Applicants foregoing arguments turn upon the nature of the filter tow (10) disclosed in the Preston reference, namely whether the filter tow (10) is rightly construed as a mass of "finite" fibers. In response, one of ordinary skill in the cigarette arts would recognize that although the filter tow of the instant process may be in this instance be considered a continuous stream of material,

the individual fibers which collectively constitute the tow are in fact characterized by a finite length. This position is supported in the Preston disclosure wherein it is clearly set forth that, "Cigarette filters have commonly been made from filter tow which consists of a cluster of crimped mono filaments" (Column 1, lines 8-10), that the tow (10) is comprised of a "stream of filaments" (Column 1, lines 20-22), and that "the pins (15) of the roller (16) engage the monofilaments of the filter tow" (Column 3, lines 44-48).

It is evident from the foregoing that the Preston tow (10) is in fact characterized as a mass of filter material comprised of individual filaments. Further, absent any compelling evidence to the contrary, said filaments are understood to be characterized by a finite length dimension. Applicants argument on this matter is deemed unpersuasive.

Finally, Applicant argues that the rollers (11) and (12) do not constitute a "metering device". Applicant alleges that one of ordinary skill in the art would recognize that a "metering device" is intended to even out variations in the flow of materials.

Specifically, Applicant recognizes that the rollers stretch the filter tow (10) but asserts that the rollers necessarily do not operate to "even out variations in the flow of fiber material".

First, the Examiner finds no support in the specification as originally filed to support Applicants asserted definition of a "metering" operation. Looking specifically to a conventional definition, the act of "metering" in the broadest reasonable contest is

construed as an act "To supply in a measured or regulated amount" ("metering." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 28 Nov. 2007. <Dictionary.com <http://dictionary.reference.com/browse/metering>>). The term metering requires only that the flow of material is regulated or measured and in no manner implies or requires that variations in the flow be "evened out".

Next, it is evident from the Preston reference that the rollers (11 and 12) are operated in a manner which is consistent with a "metering" device according to the conventional definition. Specifically, the rollers (11,12) regulate the amount of material supplied to rollers (3 and 14) by controlling or metering the amount of material supplied there between. This regulated delivery is confirmed by the functional description of the apparatus which states in part that the tow is "fed downwards between rollers 11 and 12 and then between rollers 3 and 4 which operate at a higher speed than the rollers 11 and 12 so as to stretch the tow" (Column 3, lines 35-43). The prior art apparatus clearly operates in a manner which controls and maintains the flow of fiber material such that said tow is maintained under tension in order to "stretch" the tow.

Therefore to the extent that Applicant argues that Preston does not teach metering or controlled flow of the filter material, the Examiner disagrees. Specifically, Applicant has provided no conclusive evidence in support of this assertion and it therefore follows that

these arguments are held to be mere conjecture and attorney argument. The Official policy regarding Attorney argument is clearly outlined in MPEP §2145 [R-3];

“Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571)

Application/Control Number:
10/815,959
Art Unit: 1791

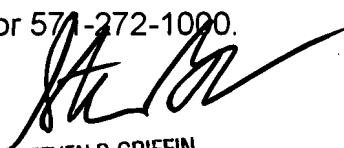
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272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL



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